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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,229	06/19/2001	Mohamed Kanji	05725.0537-00	9812

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FINNEGAN, HENDERSON, FARABOW, GARRETT &
DUNNER LLP
1300 I STREET, NW
WASHINGTON, DC 20006

EXAMINER

VENKAT, JYOTHSNA A

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 09/27/2002

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary*File Copy*

Application No.

09/883,229

Applicant(s)

KANJI ET AL.

Examiner

JYOTHSNA A VENKAT

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-118 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-118 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Receipt is acknowledged of declaration/fee, correction for filing receipt and IDS filed on 10/15/01, and 6/19/01.

Applicants are notified that the paper filed " request for corrected patent publication under 37 CFR 1.221(b) is forwarded to the certificate of correction branch.

Claims 1-118 are pending in the application and the status of the application is as follows;

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 16,31,50,65,85,99,102 and 118 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The following enumerated reasons apply:

- 1) The expression "*spherical compounds*" is ambiguous and unclear as the applicant's intent.

Recourse to the specification does not describe the *spherical compounds* (claims 16,31,50,85,99, and 118).

- 2) The expression "*biological materials*" *spherical compounds* " are ambiguous and unclear as the applicants intent. Recourse to the specification does not describe the "*biological compounds*" (claims 16,31,50,85,99, and 118).

- 3) The expression "*derivatives of any of the forgoing*" is without metes and bounds. Applicants are claiming various components that are to be added in the cosmetic formulations. Recourse to

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the specification does not define “*derivative*” for any single compound. Let alone all the compounds claimed (claims 16,31,50,85,99, and 118).

40 Claim 102 recites “*chosen from*” and yet it recites one copolymer. **Deletion of “*chosen from*”** is suggested to overcome the above rejection.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

4. Claims 1-14,16-29,31-45,47-60, 62-80,and 82-119 are rejected under 35 U.S.C. 102(e) as being anticipated by U. S. Patent 6,423,306 B2 (‘306).

The instant application is claiming compositions comprising:

1) *Polymethylsilsesquioxane*

2) *Film former which is different than the component 1)*

3. *Additives*

4) *Allyl stearate/vinyl acetate copolymer (claims 68 and 102)*

5) *Emollients, thickening agents and UV absorbers*

The claims are drawn to compositions or emulsions and these compositions are useful in lipsticks, mascara and eyeliners.

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See the abstract, see example 1 for the siloxy silicate which reads on 10 see the col.4, lines 5-62 for component 2, see col.6 for 3 and 5, see also the examples. See col.7, lines 55-60 for component 4. See the various formulations disclosed in the examples. Since the components are same the property claimed, “ long wear and transfer resistance “ is inherent absence of evidence to the contrary. The siloxy silicate disclosed in the patent reads on the generic claims as well as the specific resin and therefore the claims 8,41,56, 76,90 and 109 are inherent as the silicate has this structure inherently present absence of evidence to the contrary.

5. Claims 1-12, 14, 16, 32-45, 47, 49-60, 62, 64-65, 86-94, 96-100, 104-114, and 116-118 are rejected under 35 U.S.C. 102(e) as being anticipated by U. S. Patent 6,045,782 ('782).

The instant application is claiming compositions comprising:

1) *Polymethylsilsesquioxane*

2) *Film former which is different than the component 1)*

3. *Additives*

4) *Emollients, thickening agents*

The claims are drawn to compositions or emulsions and these compositions are useful in lipsticks, mascara and eyeliners.

See example 3 where “ *diisostearoyl trimethylpropane siloxy silicate* “ reads on component 1, “ *PVP/ eicosene copolymer* “ reads on component 2, see the various additives in the examples and also see col.8 for the emollients, see col.9 for the for” *bentonite, kaolin microcrystalline cellulose and montmorillonite*” which reads on claimed thickening agents; see also all the examples. Since the components are same the property claimed, “ long wear and transfer resistance “ is inherent absence of evidence to the contrary .The Siloxy silicate disclosed

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in the patent reads on the generic claims as well as the specific resin and therefore the claims 8,41,56, 76,90 and 109 are inherent as the silicate has this structure inherently present absence of evidence to the contrary.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1-66, 70-101, and 104-118 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U. S. Patents 6,071,503 ('503), 5,959,009('009) and 5,756,082('082).

The instant application is claiming compositions comprising:

1) Polymethylsilsesquioxane

2) Film former, which is different than the component one. The species are various styrene block copolymers

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3) *Various additives*

4) *Emollients, thickening agents and UV absorbers*

The claims are drawn to compositions or emulsions and these compositions are useful in lipsticks, mascara and eyeliners.

The patent '503 teaches transfer resistant cosmetic compositions using components 1, 3 and 4. See col.7, lines 20-50 for 1 and see cols 9-10 for components 3-4 and see all the examples. The difference between the patent and the claims are, the patent does not teach component 2. However, both the patents '009 and '082 teaches component 2 in cosmetic compositions. See col.2, lines 1-15 and see the examples ('009) and see col.2, lines 30-50.

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions of '503 and combine it with the *film formers* of '009 or '082, expecting beneficial effect to the cosmetic compositions. The motivation to use the *film former* in the compositions stems from the teachings of '009 that the compositions provide stability over prolonged periods of time and when this composition is used in mascara compositions the product results in a clear shiny product. The patent '082 also teaches that the film formers provide improved consistency and excellent aesthetics. The idea of combining the ingredients flows logically from the art for having been used in the same cosmetic compositions. This is prima facie case of obviousness.

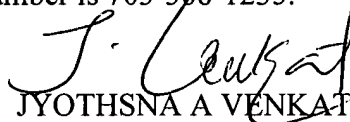
9. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A VENKAT whose telephone number is 703-308-2439. The examiner can normally be reached on M-F, 9:30-6:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THURMAN K PAGE can be reached on 703-308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3592 for regular communications and 703-308-7924 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.


JYOTHSNA A VENKAT
Primary Examiner
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September 25, 2002